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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/627,409
Filing Date: July 24, 2003
Appellant(s): RICHARD ET AL.

Arvind R. Reddy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 16, 2009 appealing from the

Office action mailed April 29, 2009

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

Claims 17-18 being rejected under 35 U.S.C. 102(b) as being anticipated by Buse et al (UK Patent Published Patent Application, GB 2 356 111 A), as indicated in the Final rejection dated 4/29/2009.

However, claims 17-18 were rejected under 35 U.S.C. 103(a) and are maintained as such; the examiner has addressed the appellants arguments below in section (10).

Therefore, the appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The grounds of rejection to be reviewed on appeal are as follows:

Claims 1-2, 5, 12, and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Buse et al (UK Published Patent Application GB 2 356 111).

Claims 4, 6, 9, 13 and 17-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buse.

Claims 3, 7, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buse as applied to claims 1 and 6, and further in view of Cole et al. (US Pat. 5,854,901), hereafter "Cole."

Claims 2-5, 6-13, and 18-19 are rejected under 35 U.S.C. § 112, second

paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim

the subject matter which Appellant regards as the invention.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Buse et al, UK Patent Published Patent Application, GB 2 356 111 A, (Sept.

5, 2001), whole document

5,854,901   COLE ET AL   12-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

2. Claims 2-5, 6-13, and 18-19 are rejected under 35 U.S.C. 112, second

   paragraph, as being indefinite for failing to particularly point out and distinctly

   claim the subject matter which applicant regards as the invention.

3. Claims 2-5, 7-13, and 18-19, recite "Process according to claim..." or "Process

   for distributing an IP address in accordance with claim..." The phrasing of the

   claim fails to establish clear antecedent basis for "Process," i.e. it is unclear if the

   applicant is referring to "A process..." or "The process…"

4. Claim 6 recites, "completing said process if an answer to said DHCP request is

   detected during said second duration T2." (lines 18-20) It is unclear what the

   applicant intends by the phrase "completing said process." Completing in what

   way? Carrying out the remaining steps? Ending the process?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

   form the basis for the rejections under this section made in this Office action:

   A person shall be entitled to a patent unless –

   (b) the invention was patented or described in a printed publication in this or a foreign country or in public
   use or on sale in this country, more than one year prior to the date of application for patent in the United
   States.

6. Claims 1-2, 5, 12, and 14are rejected under 35 U.S.C. 102(b) as being

    anticipated by Buse et al (UK Patent Published Patent Application, GB 2 356 111

    A, submitted in IDS dated March 22, 2007), hereafter "Buse."

7. As to claim 1, Buse discloses process for distributing network configuration

    settings throughout a network comprising a set of devices, including the steps of:

        establishing in at least one device a description of the network environment

    (page 5, lines 1-3, proxy device stores IP address information for a network);

        detecting in said at least one device a request for network parameters issued

    from a newly connected requesting device (page 5, lines 5-8);

        in response to said detecting starting a first timer with a first period dependent

    on a predetermined criterion (page 5, lines 8-12, proxy device starts a timer when

    sending out DHCP request);

        transmitting to said requesting device network settings in response to the

    expiration of said first period unless another one of said set of devices supplies

    network settings to said requesting device before the expiration of said first

    period (Fig. 3, label 36, and page 5, lines 11-18, IP address is transmitted from

    proxy device to new device after time-out).

8. Claim 14 is rejected by the same rationale set forth in claim 1's rejection.

9. As to claim 2, Buse discloses the network configuration settings include an Internet Protocol address and further including a step of testing the availability of said Internet Protocol address on said network prior to transmitting the network settings to said requesting device (page 5, lines 16-18).

10. As to claim 5, Buse discloses wherein said predetermined criterion is dependent on the nature of a particular device where the process is running (page 5, lines 10-13).

11. As to claim 12, Buse discloses distributing a reference of a network gateway (page 5, lines 27-32).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 4, 6, 9, 13, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buse.

14. As to claim 6, Buse discloses a process for distributing an Internet Protocol (IP)

throughout a network including at least one device comprising a network

parameter allocation (NPAA) agent performing the steps of:

detecting an address request issued by a newly connected requesting device

(page 5, lines 5-8);

in response to detecting said request starting a first timer, with a first duration

T1, in response to the detection of said address request issued by said newly

connected requesting device (page 5, lines 8-12, proxy device starts a timer

when sending out DHCP request, which is sent out on behalf of the newly

connected device);

testing whether a DHCP request received a response from a DHCP server

(page 5, lines 8-12, proxy device waits for a response);

terminating the process in response to the detection of said response within

said first duration (page 5, lines 7-9, proxy device sends DHCP reply to device

and ends process);

computing an IP address (page 5, lines 14-18);

forwarding a DHCP reply containing said computed IP address to said newly

connected requesting device (page 5, lines 7-9, proxy device sends DHCP reply

to device and ends process);.

Buse does not disclose the address request issued by a newly requesting

device is a DHCP request. Rather, Buse disclose the proxy device issues a

DHCP request on behalf of the device after receiving an address request (page 5, lines 5-8). One of ordinary skill in the art would view it as obvious that the 'I_AM_HERE' address request issued by the newly connected device is the functional equivalent of a DHCP request, do to the fact it triggers a DHCP request from the proxy device, and making it so would be a simple substitution.

Further, Buse does not disclose starting a second timer after the expiration of the first timer that is computed from a set of predetermined criteria. Rather, Buse discloses one timeout function that accomplishes both of the claimed functionality of claim 6's two timers (page 5, lines 5-18, i.e. after the time-out and no DHCP reply being received, the proxy device calculates and assigns an IP address). Therefore, one of ordinary skill in the art would view a second timer as extraneous.

15. As to claim 17, Buse discloses a process for assigning a IP address in a client device having at least one configuration file comprising at least one set of configuration parameters, said process comprising the steps of:

generating and transmitting a Dynamic Host Control Protocol (DHCP) request to said network (page 5, lines 7-9);

if no answer is received, testing the existence of one gateway corresponding to one particular set of parameters among said at least one set of configuration parameters and, if said testing indicates the existence of said gateway, loading

and applying said particular set of parameters (page 5, lines 10-27, when no answer is received, proxy device tests for the existences of IP address that it may give to a newly connected device).

But, Buse does not explicitly disclose the DHCP request is sent by the newly connected device. Rather, Buse discloses the proxy device issues a DHCP request on behalf of the device after receiving an address request from the newly connected device (page 5, lines 5-8). One of ordinary skill in the art would view it as obvious that the 'I_AM_HERE' address request issued by the newly connected device is the functional equivalent of a DHCP request, do to the fact it triggers a DHCP request from the proxy device, and having the device make such a request would be a simple substitution.

16. As to claim 4, Buse discloses wherein said predetermined criterion is related to experience gathered by said at least one device (page 5, lines 10-13).

17. As to claim 9, Buse does not explicitly disclose wherein said second duration T2 is computed from a time of operation of said device so that a particular device having a longer experience of the network has a lower time of response compared to another device having a relatively shorter experience of the network.

However, Buse discloses allowing a DHCP server a period of time to reply to a request. Therefore, Official Notice (see MPEP ' 2144.03 Reliance on "Well Known" Prior Art) is taken that adjusting this period of time would have been obvious modification to one of ordinary skill in the art at the time of the invention, as having a flexible timer for differing devices is a common practice in the art and is done in order to increase efficiency and decrease errors.

18. As to claim 13, Buse does not explicitly disclose distributing a booting image to said newly connected requesting device.

However, Official Notice (see MPEP ' 2144.03 Reliance on "Well Known" Prior Art) is taken that distributing a booting image to a newly connected device is a common and well-known practice in the art to one of ordinary skill in the art at the time of the invention, as in any managed network the administrator would like to have direct control of the managed devices, including their booting procedure.

19. As to claim 18, Buse discloses determining a particular context corresponding to the booting of said device and loading the network configuration settings corresponding to said context (page 5, lines 5-11).

20. Claims 3, 7, and 10-11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Buse as applied to claims 1 and 6 above, and further in view

of Cole et al. (US Pat. 5,854,901), hereafter "Cole."

21. As to claims 3 and 10, Buse discloses an elaboration of said network

environment is performed via access to Address Resolution Protocol tables in the

network (page 5, lines 17-20).

But, Buse does not disclose an elaboration of said network environment is

performed via access NSLOOKUP tables available in the network as well.

However, Cole discloses an elaboration of said network environment is

performed via access to Address Resolution Protocol tables and NSLOOKUP

tables available in the network (Abstract, lines 10-18 and column 3, lines 44-64).

Therefore it would have been obvious to one of ordinary skill in the art at the

time of the invention to combine the teachings of Buse and Cole in order to utilize

DNS to ensure IP address availability, thus making Buse a more effective system

than just using ARP alone.

22. As to claim 7, Buse discloses the invention substantially with regard to the parent claim 6, but does not explicitly disclose the second timer is disregarded when said device is a router.

However Cole discloses handling address assignment for routers differently, specifically by not utilizing timers (column 3, lines 55-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Buse and Cole in order more easily assign IP addresses to routers which make up the back bone of any IP network.

23. As to claim 11, Buse discloses the invention substantially with regard to the parent 6, but does distributing the reference to an existing Hyper Text Transfer Protocol (HTTP) proxy.

However Cole discloses distributing the reference to an existing Hyper Text Transfer Protocol (HTTP) proxy (column 2, lines 28-35).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Buse and Cole in order utilize a widely used protocol to carry out Buse's system.

24. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buse as applied to claim 6 above, and further in view of Taniguchi (US Pat. 6,928,282).

25. As to claim 8, Buse discloses the invention substantially with regard to the parent claim 6, but does not disclose said second duration $T.sub.2$ is derived from a computation of both the Media Access Control (MAC) parameter of said device and said newly connected requesting device. Rather, all devices are treated the same and no priority is given to any device when calculating the times.

   However, Taniguchi discloses assigning addresses based upon priority values and this will inherently include time values that are associated with parameters of the prioritized device (column 8, lines 32-39).

   Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Buse and Cole in order to have devices that have higher priority (Taniguchi's system) have different time periods in DHCP server interactions than lower priority devices.

26. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buse as applied to claim 17 above, and further in view of Liming (US Pub. No. 2002/0055924).

27. As to claim 19, Buse discloses the invention substantially with regard to the
parent claim 17, but does not disclose said context is determined from the
location of the device, as returned by a GPS receiver.

However, Liming discloses said context is determined from the location of the
device, as returned by a GPS receiver [0014].

Therefore it would have been obvious to one of ordinary skill in the art at the
time of the invention to combine the teachings of Liming and Buse in order more
easy manage IP addresses by utilizes the geographic information of the devices
requesting addresses.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and
addresses replies individually.

(1) The appellant argues with respect to the 35 USC 102(b) rejection of claim 1 that
Buse does not teach "detecting in said at least one device a request for network
parameters issued from a newly connected requesting device and in response to
detecting said request starting a first timer with a first period dependent on a
predetermined criterion." Specifically, the appellant contends transmission from a newly

connected network device to the Buse proxy is merely a reply to earlier sent
interrogation transmission from the proxy, and the reply is one that is provided by all
devices on the network that includes the IP address of the device. Therefore, the
appellant alleges the Buse reference is distinguishable from a request from network
parameters issued from a newly connected requesting device as recited in claim 1.

In reply to argument (1), even though Buse's newly connected devices
"I_AM_HERE" message with a dummy IP address (Buse, page 5, lines 5-8) may be in
response to the proxy's inquiry does not preclude the message from being a request for
network parameters. Further, the "I_AM_HERE" message with the dummy IP address
is a request for network parameters (e.g. an IP address) from the newly connected
device, as the device has included the dummy IP address in the message to indicate it
needs an IP address and receives one in response to the message (Buse, page 5, lines
5-12). Buse may not refer to "I_AM_HERE" message as an explicit request, but it is
functionally equivalent to the claim, and one of ordinary skill in the art would recognize
the message as a request due to the response that it generates.

(2) The appellant argues with respect to 35 USC 102(b) rejection of claims 17-18 in
a similar vein to that of claim 1's rejection.

In reply to argument (2), as indicated above the examiner has withdrawn these
rejections.

(3) The appellant argues with respect to the 35 USC 103(a) rejection of claim 6 that

Buse does not teach "detecting a Dynamic Host Protocol request issued by a newly

connected requesting device and in response to detecting said request starting a first

timer, with a first timer, with a first duration T1, in response to the detection of said

Dynamic Host Protocol request issued by said newly connected device." Specifically,

the appellant contends the appellant contends transmission from a newly connected

network device to the Buse proxy is merely a reply to earlier sent interrogation

transmission from the proxy, and the reply is one that is provided by all devices on the

network that includes the IP address of the device. Therefore, the appellant alleges, the

Buse reference is distinguishable from detecting a Dynamic Host Protocol (DHCP)

request issued by a newly connected requesting device as recited in claim 6.

In reply to argument (3), even though Buse's newly connected devices

"I_AM_HERE" message with a dummy IP address (Buse, page 5, lines 5-8) may be in

response to the proxy's inquiry does not preclude the message from being a request for

network parameters. Further, the "I_AM_HERE" message with the dummy IP address

is a request for network parameters (e.g. an IP address) from the newly connected

device, as the device has included the dummy IP address in the message to indicate it

needs an IP address and receives one in response to the message (Buse, page 5, lines

5-12). Buse may not refer to "I_AM_HERE" message as an explicit request, but it is

functionally equivalent to the claim, and one of ordinary skill in the art would recognize the message as a request due to the response that it generates.

Further, it was never the examiner's contention that Buse disclosed that the address request issued by a newly connected device was a DHCP request (hence, the 103(a) rejection), and the appellant's more specific arguments in this regard are addressed below in reply to argument (4).

(4) The appellant argues with respect to the 35 USC 103(a) rejection of claim 17 in a similar vein to that of claim 6 (see response above), and additionally argues the examiner's allegation of employing a DHCP request for the newly connected device would be "a simple substitution" is improper. Specifically, the appellant contends the Office Action fails to cite any reference or evidence for this contention and further contends, "generating a DHCP request *and* testing the existence of one gateway corresponding to one particular set of parameters among said at least one set of configuration parameters and, if said testing indicates the existence of said gateway, loading and applying said particular set of parameters is too complex for a person of ordinary skill in the art to be considered well known without citing additional evidence and/or references."

In reply to argument (4), Buse does not explicitly disclose the address request issued by a newly requesting device is a DHCP request. Rather, Buse discloses the proxy device issues a DHCP request on behalf of the device after receiving an address

request (page 5, lines 5-8). One of ordinary skill in the art would view it as obvious that

the 'I _AM_HERE' address request issued by the newly connected device is the

functional equivalent of a DHCP request, due to the fact it triggers a DHCP request from

the proxy device, and making it a DHCP would be a simple substitution and mere

rearrangement of known parts (i.e. having the newly connected device issue a DHCP

request to the proxy, then having the proxy relay the DHCP directly).

That is, the examiner has provided evidence of DHCP requests in the form of Buse

(page 5, lines 5-8) contrary to the appellant's assertion. Therefore, allowing the newly

connected device to issue an already disclosed DHCP request would have been a

design choice and obvious to one of ordinary skill in the art at the time of the invention

as it is merely a rearrangement of the known parts of Buse's invention. See MPEP

2144.04 (IV) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Furthermore, the examiner's proposed modification would have neither changed the

principle operation/predictable result of Buse's invention (allocating IP address, see

page 1, lines 7-9; i.e. a newly connected device would still receive IP address) nor

required any additional acts or structure as DHCP requests are already explicitly

disclosed and the proposed modification would have been mere rearrangement via

simple substitution.

Lastly, the examiner fails to see how such a modification would be "too complex" for

a person of ordinary skill in the art given the teachings of Buse. Specifically, the

examiner has already established that Buse explicitly discloses DHCP requests and

further discloses the testing limitations of claims 6 and 17 (see section (9), Grounds of

Rejection), and a simple substitution that leads to a predictable result has been

established as not being too complex for one of ordinary skill in the art as "a person of

ordinary skill has good reason to pursue the known options within his or her technical

grasp [and] if this leads to anticipated success, it is likely the product not of innovation

but of ordinary skill and common sense."   See *KSR International Co. v. Teleflex Inc.,*

550 U.S.-, 82 USPQd 1385 (2007).

(5) The appellant argues that the rejections of claims 2-5, 6-13, and 18-19 under 35

U.S.C. 112 are improper as the claims comply with 35 USC 112 second paragraph, and

"process" has clear antecedent basis in the claims.

In reply to argument (5), reciting, "Process according to claim..." in the preamble of

a dependent claim fails to clearly identify the process of the parent claim. As the

appellant has chosen to not use articles in their claims, it is not merely the appellant

asserting their freedom of claiming that which the "applicant regards as his invention,"

but rather has caused the claims to fail to have clear antecedent basis. That is, if the

claim were to recite, "**The** process according to claim..." it is known what process is

being referred to. If the claim were to recite, "**A** process according to claim..." it is clear

that a new process is being claimed. Failure to recite either simple causes

indefiniteness.

(6) The appellant argues that the rejection of claim 6 under 35 U.S.C. 112 is improper as the claim language would be understood by a person of ordinary skill in the art in light of the specification.

In reply to argument (6), the examiner disagrees and maintains that the language used is indefinite. The claim does need to spell out how the process of is completed due to the fact that divergent interpretations of the claim language exist (i.e. the interpretation of "completing said process" could be either carrying out remaining steps or ending the process abruptly) leads to an ambiguous claim and therefore fails to particularly point out and distinctly claim the subject matter.

Furthermore, the examiner notes although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For at least the above reasons, claims 1-14 and 17-19 stand rejected.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Thomas J. Dailey

/T. J. D./

Examiner, Art Unit 2452

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/Kenny S Lin/

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